UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/486,125	06/12/00	SHETTY A	287300023P0A

000757
QM32/0813
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO IL 60610

EXAMINER	
SMITH,R	
ART UNIT	**PAPER NUMBER**
3737	11

DATE MAILED: 08/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/486,125	Applicant(s) SHETTY ET AL.	
	Examiner Ruth S Smith	Art Unit 3737	

-- Th MAILING DATE of this communication appears on the cover sh et with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 July 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) *16-18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 June 2000* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Election/Restrictions

Claims 16-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10.

Drawings

The drawings are objected to because figure 4 does not show details on how views are divided into partitions as disclosed on page 5. Correction is required.

Specification

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 112

Claims 6-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6-8 are vague and indefinite in that it is unclear as to what further active steps in the method have been set forth. Claim 10 is vague and indefinite in that it is unclear as to what further structural limitation has been set forth. Claims 9,12 are incomplete in that the preamble refers to an injection of contrast agent, however, the body of the claim fails to set forth means for providing a single injection of contrast agent. In claim 13, "said contrast agent" lacks antecedent basis. It is only inferentially set forth in the preamble of claim 12.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1,3,8-10,12 are rejected under 35 U.S.C. 102(b) as being anticipated by applicant's admission of the prior art. The claims are directly readable on the use of a conventional MRI system to perform two different scans on a patient as is old and well known in the art. With respect to claim 10, the time it takes to set up for a second scan would inherently provide the patient enough time to breathe and hold their breath again.

Claims 1,8-10,12 are rejected under 35 U.S.C. 102(e) as being anticipated by Damadian. The claims are directly readable on Damadian which includes using a first set of parameters to image at a first location using MRI and then based upon the next predicted location of the contrast material loading a second set of parameters to image the second location using MRI.

Claims 1,2,8,9,11,12,14 are rejected under 35 U.S.C. 102(e) as being anticipated by Hurd et al. The claims are directly readable on Hurd et al which discloses acquiring imaging data using a first set of parameters and then acquiring imaging data using a second set of parameters. After the scan is completed the image data acquired from each set of parameters is processed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurd et al or Damadian in view of Riederer et al. Hurd et al disclose acquiring imaging data using a first set of parameters and then acquiring imaging data using a second set of parameters. After the scan is completed the image data acquired from each set of parameters is processed. Damadian includes using a first set of parameters to image at a first location using MRI and then based upon the next predicted location of the contrast material loading a second set of parameters to image the second location using MRI. Riederer et al disclose an MRI system which includes a stimulus for prompting the patient when they can breathe. The stimulus can be audible or visual. It would have been obvious to one skilled in the art to have modified either Hurd et al or Damadian such that it includes a means for indicating to a patient when they can breathe in order to allow the patient to have some form of indicator which shows how much longer they must stay still.

Claims 4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's own admission in view of Matsutani. It is old and well known in the art to acquire several different scans of a patient if different parts of the body need to be examined. Each would inherently involve different scan parameters and the need to reposition the patient such that the desired body portion is correctly positioned within the magnet bore. Matsutani is an example of such and discloses that it is to automatically position a patient via a drive device. It would have been obvious to one skilled in the art to have modified the prior art such that a drive device is used to properly position the patient.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hurd et al in view of Bahn. Hurd et al disclose acquiring imaging data using a first set of parameters and then acquiring imaging data using a second set of parameters. After the scan is completed the image data acquired from each set of parameters is processed. Bahn discloses the use of a contrast agent which is injected into the patient in order to provide enhanced MR images. It would have been obvious to one skilled in the art to have modified Hurd et al such that a contrast agent is provided. The advantage of such is to enhance the image obtained as is a well known expedient in the art. The use of such a contrast agent in the method of Hurd et al would inherently result in the step set forth in claim 13.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S Smith whose telephone number is 308-3063. The examiner can normally be reached on M-F 5:30AM -2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on 308-3256. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703) 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0858.

Ruth S Smith
Primary Examiner
Art Unit 3737

RSS
July 18, 2001